

**REMARKS**

Claims 1-17 are pending and stand ready for further action on the merits.

Claim 1 has been amended to clarify that R<sup>1</sup> is not an acid labile group or an adhesive group.

Claim 2 has been amended to be in independent form.

Claims 3, 5, 7 and 9 have been amended to depend from claim 2 instead of claim 1.

New claim 15 finds support on pages 19-21 of the specification.

New claim 16 finds support on page 22.

New claim 17 finds support on page 23.

No new matter has been added by way of the above-amendment.

**Issues Under 35 U.S.C. § 103(a): Sasaki '277**

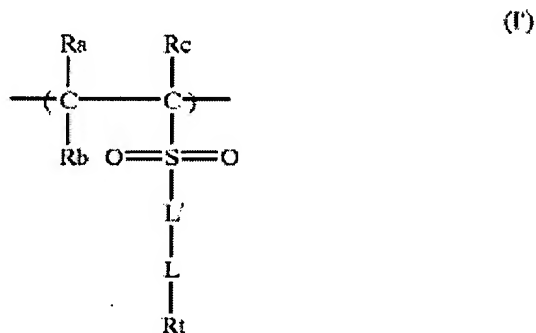
Claims 1 and 3-14 are rejected under 35 U.S.C. § 103(a) as being obvious over Sasaki et al., U.S. Publication No. 2003/0232277 (hereinafter referred to as Sasaki '277). Applicants respectfully traverse the rejection.

As the Examiner will note, claims 3-9, 13 and 14 now depend (directly or indirectly) from claim 2 which has been made independent. Accordingly, the rejection with respect to claims 3-9, 13 and 14 has been rendered moot. Applicants now discuss the patentable distinctions between claims 1 and 10-12 as presently amended, and the teachings of Sasaki '277.

Upon careful review of Sasaki '277, it appears that the Examiner has improperly characterized the teachings of this reference.

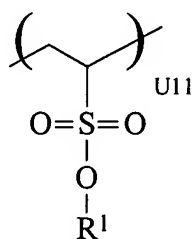
The Examiner appears to be relying upon formula (I') of claim 6 of Sasaki '277 for teaching the sulfur containing moiety of claim 1 as follows:

Formula (I') of claim 6 of Sasaki '277:



wherein Ra, Rb and Rc each independently represents a hydrogen atom, a fluorine atom or a fluorinated alkyl group, L represents a single bond or a binding group, Rt represents an alkyl group, an alicyclic alkyl group, an aryl group or an aralkyl group, and L' represents a single bond or an oxygen atom.

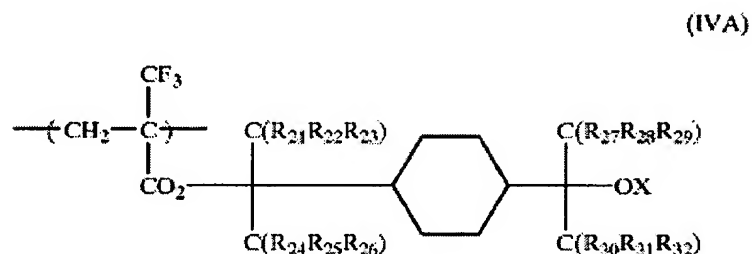
The Examiner is equating the above formula (I') with the instant sulfur containing moiety having the following structure:



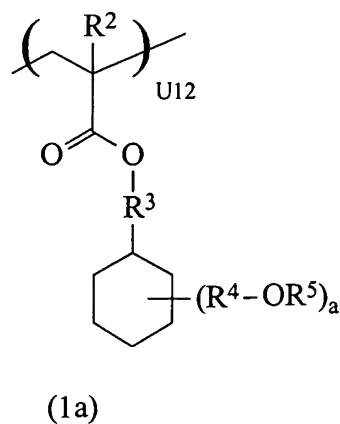
wherein R<sup>1</sup> is a straight, branched or cyclic fluorinated alkyl group of 1 to 20 carbon atoms which may contain a hydrophilic group such as hydroxyl,

Also, the Examiner appears to be relying upon Formula (IVA) of Sasaki '277 at paragraph 0028 as overlapping with the ester moiety of claim 1 as follows:

Formula (IVA) of Sasaki '277:



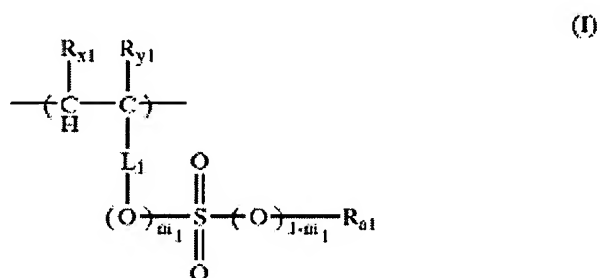
The Examiner is equating the above Formula (IVA) with the instant ester containing moiety having the following structure:



Even assuming *arguendo* that the moieties of Formulae (I) and (IVA) of Sasaki '277 overlap with the formulae (1a) and (1b) of instant claim 1, Sasaki '277 does not teach or suggest

that the moieties of Formulae (I') and (IVA) are on the same polymer as asserted by the Examiner. These moieties are taught to be used in separate compositions by Sasaki '277.

Specifically, Sasaki '277 teaches that Formula (IVA) is to be used with Formula (I) as follows:



It is most important for the Examiner to note that  $L_1$  is always present as a "divalent binding group". Such a divalent binding group is not present on the instant ester containing moiety of formula (1a).

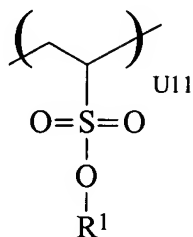
As the MPEP directs, all the claim limitations must be taught or suggested by the prior art to establish a *prima facie* case of obviousness. See MPEP § 2143.03. In view of the fact that Sasaki '277 fails to teach or suggest the use of instant formula (1a) or (1b), a *prima facie* case of obviousness cannot be said to exist. Accordingly, withdrawal of the rejection is respectfully requested.

**Issues Under 35 U.S.C. § 103(a): Kishimura '035 and Oberlander et al.**

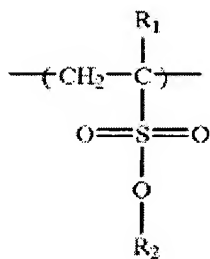
Claims 1, 9, 10, 13 and 14 are rejected under 35 U.S.C. § 103(a) as being obvious over Kishimura et al., U.S. Publication No. 2004/0029035 (hereinafter referred to as Kishimura '035) in view of Oberlander et al., USP 6,844,131. Applicants respectfully traverse the rejection.

As the Examiner will note, claims 3-9, 13 and 14 now depend (directly or indirectly) from claim 2 which has been made independent. Accordingly, the rejection with respect to claims 9, 13 and 14 has been rendered moot. Applicants now discuss the patentable distinctions between claims 1 and 10, as presently amended, and the teachings of Kishimura '035 and Oberlander et al.

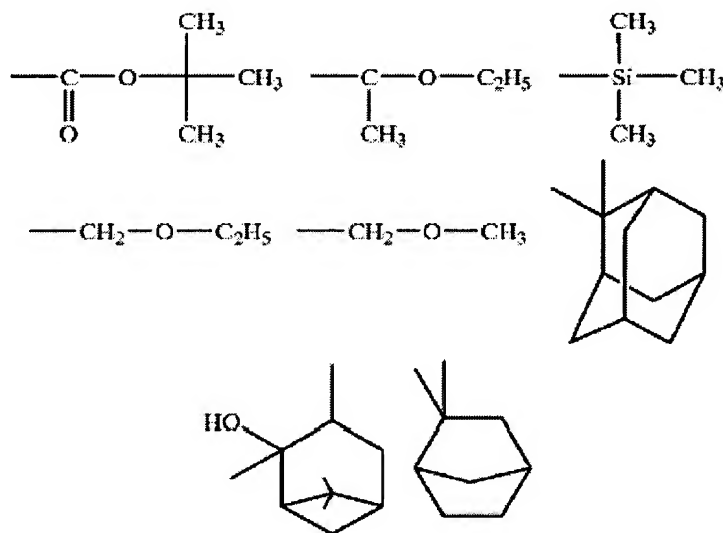
Applicants respectfully submit that Kishimura '035 and Oberlander et al. fail to teach or suggest the compounds of independent claim 1, as presently amended. Inventive claim 1 recites the following moiety:



wherein R<sup>1</sup> is a straight, branched or cyclic *fluorinated* alkyl group of 1 to 20 carbon atoms which may contain a hydrophilic group such as hydroxyl. The Examiner is equating the above-formula with the Chemical Formula 1 of Kishimura '035 which can be found in the abstract and is as follows:

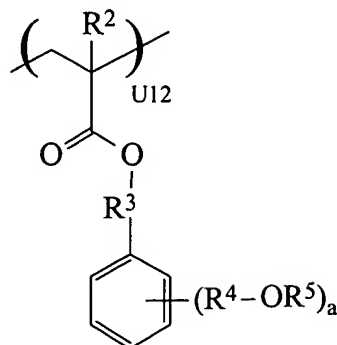


wherein R<sub>2</sub> is "a protecting group released by an acid." However, it is clear from the discussion of Kishimura '035 that the "protecting group released by an acid" does not include a straight, branched or cyclic *fluorinated* alkyl group of 1 to 20 carbon atoms which may contain a hydrophilic group such as hydroxyl, as recited in R<sup>1</sup> of the present invention. For example, Kishimura '035 teach at paragraph 0108 that the "protecting group released by an acid" has the following structures:



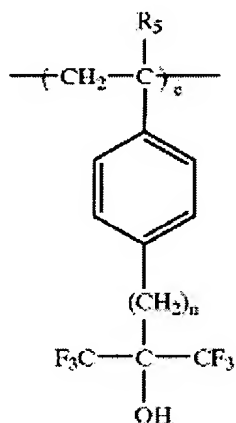
Accordingly, Kishimura '035 fail to teach or suggest the sulfur containing moiety of inventive claim 1 having a fluorinated alkyl group bonded to an oxygen of the SO<sub>3</sub> radical.

Furthermore, the Examiner appears to be aware that Kishimura '035 fail to teach or fairly suggest the ester containing moiety as follows:



The Examiner notes that Kishimura '035 teaches the following moiety:

[0041] Chemical Formula 4:



The Examiner is aware that this moiety of Kishimura '035 does not include an ester linkage, as is required by the inventive claims. The Examiner has taken the position that it would be obvious to modify this moiety of Kishimura '035 to include an ester linkage based on the teachings of Oberlander et al. at column 7, lines 55-61. Applicants respectfully submit that the skilled artisan would not be motivated to modify Chemical Formula 4 of Kishimura '035 to add an ester linkage based upon the teachings of Oberlander et al. at column 7, lines 55-61 in view of the distinctions between the Chemical Formula 4 of Kishimura '035 and the specific compounds of

Oberlander et al. at column 7, lines 55-61. Oberlander et al. teach at column 7, lines 55-61 the following compounds:

The preferred chromophores are vinyl compounds of substituted and unsubstituted phenyl, substituted and unsubstituted anthracyl, and substituted and unsubstituted naphthyl; and more preferred monomers are styrene, hydroxystyrene, acetoxystyrene, vinyl benzoate, vinyl 4-tert-butylbenzoate, ethylene glycol phenyl ether acrylate, phenoxypropyl acrylate, 2-(4-benzoyl-3-hydroxyphenoxy)ethyl acrylate, 2-hydroxy-3-phenoxypropyl acrylate, phenyl methacrylate, benzyl methacrylate, 9-anthracenylmethyl methacrylate, 9-vinylanthracene, 2-vinylnaphthalene.

It is clear from this list of compounds that none of the phenyl groups have a hydroxy substituted fluorinated alkyl substituent as is required by Chemical Formula 4 of Kishimura '035. Thus, the distinctions are of a magnitude as to lead the skilled artisan to believe that there would not be a reasonable expectation of success to modify Chemical Formula 4 of Kishimura '035 to add an ester linkage based upon the teachings of Oberlander et al. at column 7, lines 55-61. Accordingly, the inventive claim 1 is not made obvious over the combination of Kishimura '035 and Oberlander et al., and withdrawal of the rejection is respectfully requested.

With the above remarks, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.



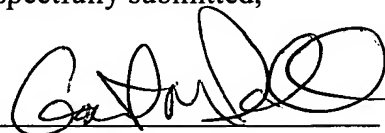
Application No. 10/773,228  
Amendment dated August 30, 2005  
Reply to Office Action of June 1, 2005

Docket No.: 0171-1062P

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq. (Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Dated: August 30, 2005

Respectfully submitted,

By  #43575  
Gerald M. Murphy, Jr. for  
Registration No.: 28,977  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Rd  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant